

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Eog-kyu KIM

Application No.: 10/769,768

Group Art Unit: 2609

Filed: February 3, 2004

Examiner: Hassen A. Mia

For: A MAIN TERMINAL AND METHOD OF OPERATING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Alexandria, Virginia 22313

Sir:

In response to the Office Action mailed on October 3, 2007, Applicant provisionally elects Group II, Species 1, directed to: (a) claims 6, 7, and 9-14 and (b) claims 6, and 8-14 with traverse.

In the Office Action of October 3, 2007, the Examiner has required Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. In particular, the Examiner contends that Group I (claims 1-5) and Group II (claims 6-16) include patentably distinct Species 1-3 and 1-2, respectively, having mutually exclusive characteristics for each identified species. The Examiner then alleges that there is an examination and search burden for these separate species due to their mutually exclusive characteristics.

Applicant respectfully traverses the restriction requirement for at least the following reasons.

As to the restriction between Group I (claims 1-5) and Group II (claims 6-16), Applicant respectfully submits that Groups I and II are sufficiently related such that a thorough search for the subject matter of Group I would encompass a search for the subject matter of Group II. In fact, all of claims 1-16 are directed to "a main terminal," "an external terminal," "a telephone network," and "an internal current...from a loop voltage," to achieve the desired results. As a result, the subject matter of all of claims 1-16 overlap in scope. Therefore, the Examiner would be required to perform the same search of class 379, subclass 413 for each Group. In addition,

even though the Examiner has classified Group I and Group II into the same class 379 and subclass 413, the Examiner has not indicated a particular different field of search which would be pertinent to the type of subject matter covered by the claims as required by MPEP §808.02. Accordingly, Applicant respectfully submits that the Restriction Requirement is improper, and that a thorough search of class 379, subclass 413 could be performed for each claim in the same field of search.

With respect to Group II, the Examiner has divided Group II into separate Species 1-2, alleging that “the species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.” (See Detailed Action, page 3). However, Applicant respectfully submits that Species 1 and Species 2 of Group II are not distinct because each Species is directed to “a main terminal,” “an external terminal,” “a telephone network”, and “an internal current...from a loop voltage” to achieve the desired results. In fact, claims 6 and 15, which are identified by the Examiner as being generic to Species 1 and 2, are both directed to a main terminal to selectively connect an external terminal to a telephone network by an internal current signal generated when the external terminal is in connection with the telephone network. In other words, Species 1 and Species 2 of Group II are not distinct because the elements of Species 1 overlap the elements of Species 2. Accordingly, Applicant respectfully submits that the Restriction Requirement is not proper according to the criteria of distinctness for combination, sub-combination, or element of a combination according to MPEP §806.05(c). Therefore, withdrawal of the Restriction Requirement is respectfully requested.

In the language of MPEP §803, “if the search and examination of all the claims in the application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions” (underlining added for emphasis). It is respectfully submitted that this policy should apply in the instant case in order to avoid unnecessary delay and expense to Applicant and to avoid duplicative examination by the Patent Office.


NOTE: Regarding Group I (claims 1-5), Applicant notes that the Examiner has not identified claim 1 as being part of Species 1, 2 or 3. Applicant assumes this to be an oversight on the part of the Examiner. For purposes of the instant response, Applicant assumes the Examiner intended to include claim 1 in Group I, Species 1.

Based on the foregoing, reconsideration and withdrawal of the Restriction Requirement with respect to Group I, Species 1-3 and Group II, Species 1-2 are respectfully requested.

Respectfully submitted,

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Date: 10/31/2007

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